

REMARKS

This paper includes the arguments from the May 24, 2006 reply, and further includes amendments and corresponding comments that address the inadvertent omissions identified in the August 4, 2006 paper.

A. The Objection to the Abstract Is Overcome

The sentence in the Abstract to which the Patent Office objects has been deleted, and the objection is overcome. The deletion is not an indication or acquiescence that other embodiments of the invention are not disclosed in the application; they are. Applicant makes this amendment for the sole reason of expediting prosecution.

B. The Clarity Objections Are Overcome

The Office asserts that the preambles of independent claims 1, 9 and 17 are objectionable under Rule 75(a) because, in essence, they are short. Of claim 1, which recites “A method comprising:”, the Office asks, “a method for what exactly is being referred to here?” The method being referred to is in the body of the claim. If the steps listed in the body of the claim are met, the claimed method is performed. There is no legal requirement that Applicant use a more descriptive or word-intensive preamble, and there is no evidence that one of ordinary skill in the art would find the claims insolubly ambiguous without a more descriptive preamble. Applicant can locate many, many issued patents with claim preambles as simple as those of the present claims (*see, e.g.*, U.S. 7,042,898).

The Office objects to claim 1 and its dependents because the claim phrase “creating a filter structure using a parameter of a periodic pulse train” purportedly does not “particularly point out *how exactly* the parameter of the periodic pulse train is being used to create the filter structure.” (Emphasis added). The claims need not serve such a function. As the Federal Circuit explained several years ago:

If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment. Nor would a basis remain for the statutory necessity that an applicant conclude his specification with “claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112. It is the claims that measure the invention. . . . Specifications teach. Claims claim.

SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121 and n.14 (Fed. Cir. 1985) (en banc); *see also Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575 (Fed. Cir. 1986) (describing the invention “is the role of the disclosure portion of the specification, not the role of the claims”). The current specification adequately provides an enabling description of the disputed claim language. Moreover, the Office has provided no evidence that a person of ordinary skill in the art would find the disputed claim language—when viewed in light of the specification—insolubly ambiguous. Accordingly, claim 1 and its dependents possess the clarity required by Rule 75(a), as do claims 9 and 17 and their respective dependents that include comparable claim language. The claim phrase “receiving a pulse at a time” in claim 1 is sufficiently clear for the same reasons.

Claims 4, 12 and 17 have been amended to address the remaining clarity objections. Those objections are now overcome.

C. The 101 Rejection Is Overcome

Claims 9-16 have been amended to replace the phrase “computer readable medium” with “data storage device” in order to expedite prosecution. Non-limiting examples of data storage devices are listed on page 10 of the specification. Accordingly, the subject matter rejection of these claims is overcome.

D. Conclusion

Applicant appreciates the indication of allowability of claims 1-8 and 17-19 subject to the Rule 75(a) objection, and submits that all the pending claims are now in condition for allowance. The Commissioner is authorized to deduct any fees required by this paper from Fulbright & Jaworski L.L.P. Account No.: 50-1212/BAES:027US/MTG.

Date: August 8, 2006

Respectfully submitted,

/Mark T. Garrett/

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
Telephone: (512) 536-3031
Facsimile: (512) 536-4598

Mark T. Garrett
Reg. No. 44,699
Attorney for Applicant